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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
2003-IP-009956 U1 USA

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on MAY 18, 2006

Signature Sherra Suffko

Typed or printed name SHERRA SUFFKO

Application Number	Filed
10/658,899	September 10, 2003

First Named Inventor
Michael L. Fripp

Art Unit	Examiner
3672	K. Thompson

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☑ attorney or agent of record. Registration number 38,310
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Marlin R. Smith
Signature

Marlin R. Smith
Typed or printed name

972-516-0030
Telephone number

May 17, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	Michael L. Fripp, et al.
Serial No.:	10/658,899
Filed:	September 10, 2003
Entitled:	BOREHOLE DISCONTINUITIES FOR ENHANCED POWER GENERATION
Group Art Unit:	3672
Examiner:	K. Thompson

PRE-APPEAL BRIEF REQUEST FOR REVIEW ARGUMENTS

Pursuant to the Office Action dated February 23, 2006, which was indicated as being final, most of the claims being considered in the present application are indicated as being allowed, or as containing allowable subject matter. However, a few claims remain rejected as being anticipated by one or more of the Tubel (US 5,839,508), Hall (US 5,295,397) or Wilson (US 2,960,109) references. The applicants respectfully traverse these rejections and, since there is an omission of one or more essential elements needed for a *prima facie* rejection, along with clear error in the factual basis for the rejections, this Pre-Appeal Brief Request for Review is submitted accompanying a Notice of Appeal.

The present application describes several unique methods of redirecting fluid flow through a flow passage in a subterranean well. In an example illustrated in FIGS. 2 & 3 (the present species elected with traverse), flow restrictors 40 are positioned in the passage 34 to cause a portion 50 of the fluid to flow into an adjacent region 52, so that a generator 60 can produce electrical power due to the fluid flow through the region. An advantage of the invention is that the main passage 34 is not substantially obstructed by the restrictors 40.

Please note that claim 1 recites that the claimed apparatus includes flow restrictors which are operative to influence fluid to flow from a flow passage to a flow

region (the flow passage and flow region being further defined in the claim). Similarly, claim 11 recites an electrical power generating system which includes flow restrictors which are operative to influence fluid to flow from a first flow passage and through a flow region.

Thus, each of the rejected independent claims 1 and 11 recites that multiple flow restrictors in a flow passage influence at least a portion of fluid in the passage to flow from the passage and to or through a flow region in communication with the passage. The applicants respectfully submit that none of the Hall, Wilson and Tubel references describes this feature of the invention recited in claims 1 and 11, and thus none of these references anticipates these claims or their dependents.

As suggested in the Office Action, the Hall reference does describe multiple restrictions in a slotted orifice plate 12 positioned between upstream and downstream portions of a flow passage. However, the orifice plate 12 clearly does not influence any portion of the fluid to flow from the upstream to the downstream portions of the passage, nor does the orifice plate influence any portion of the fluid to flow through the downstream portion of the passage. Instead, the orifice plate 12 retards flow through both the upstream and downstream portions of the passage. The fluid would flow between the upstream and downstream portions of the passage, and through the downstream portion of the passage, whether or not the restrictions in the orifice plate 12 were present. Therefore, the orifice plate 12 does not influence any fluid to flow from the upstream portion of the passage to the downstream portion of the passage, and Hall does not anticipate claims 1 or 11, or any of their dependents.

Similarly, both Wilson (FIG. 5, elements 54, 60) and Tubel (FIG. 12, elements 90) describe inline flow restrictions which may retard flow upstream and downstream of the restrictions. However, these restrictions do not influence any portion of the fluid to flow from the upstream to the downstream portions of the passage, nor do the restrictions influence any portion of the fluid to flow through the downstream portion of the passage. The fluid would flow between the upstream and downstream portions of the passage, and through the downstream portion of the passage, whether or not the

restrictions were present. Therefore, neither Wilson nor Tubel anticipates claims 1 or 11, or any of their dependents.

In summary, the references do not teach the elements and limitations recited in the independent claims, and thus a *prima facie* case of anticipation has not been made out. Accordingly, withdrawal of the rejections is respectfully requested.

Respectfully submitted,

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Dated: May 17, 2006

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on MAY 18, 2006